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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/058,537      | 01/28/2002  | Thomas Silva         | 1164.001            | 3710             |

7590 02/18/2005  
Richard L. Sampson  
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EXAMINER

ONEILL, MICHAEL W

ART UNIT PAPER NUMBER

3713

DATE MAILED: 02/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                      |                                      |  |
|------------------------------|--------------------------------------|--------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/058,537 | <b>Applicant(s)</b><br>SILVA, THOMAS |  |
|                              | <b>Examiner</b><br>Michael O'Neill   | <b>Art Unit</b><br>3713              |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2004.
- 2a) ☒ This action is **FINAL**.      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4-12, 39-43 and 55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-12, 39-43 and 55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35

U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 2, 4-12, 39-43 and 55 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. It is unclear from review of the disclosure where in the specification and drawings is the new claimed subject matter presented within these amended claims. The Applicant neglected to provide guidance as to where these limitations could be found within the originally filed disclosure.

The following is a quotation of the second paragraph of 35

U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 1, 2, 4-12 and 55 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 1 and 55 (and the dependent claims thereto do not correct or make any clearer), there is disagreement between the preamble and the claim body. The preamble presents the claim as directed to a "display", thus an article of manufacture. The claim body contains limitations that direct it to be a gaming machine, e.g. a random number generator, input module and the like. Thus, it is unclear whether the Applicant is claiming an article of manufacture or a machine. Also, it should be noted that claim 4 has a lack of antecedent basis for the term "privately held companies". Moreover, claim 12 as an issue with not being inconsistent with the claim body of claim 1, e.g. the appear to be another "random number generator" being claimed; and it is unclear how a "display" can be a "table game" and have machine limitations being claimed as well, see the latter half of claim 1.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 2, 4, 5, 8, 11, 12, 39, 41-43 and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Payne et al., USPN 6,676,511 in view of Oranges et al., USPub 2001/0041609 and Colapinto et al., USPN 6,523,824.

Payne et al., as shown in the drawings, discloses an electronic triangular display within a gaming machine. Contained within this gaming machine is a random number generator, not shown, but inferred by the player "spins" block (56) of figure 2a. The blocks with the markings that are the representatives for the game of chance are disclosed in figure 3. What Payne lacks in clearing disclosing is the markings

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being a class of indicia for advertisements and the particular range of rows and blocks claimed. With respect to the latter limitation of the range of rows and blocks, one skilled in this art understands, that absent a showing of criticality in any particular range, the range is an obvious design choice left to the inventor's discretion. With respect to the former limitation of the markings representing business entities, Oranges and Colapinto are being shown in order to demonstrate that it is well known to those skilled in this art to provide as symbols indicia representing companies and thus being advertisements for said companies. Hence, one of ordinary skill in the art would find it obvious to incorporate the teachings of Oranges and Colapinto into the symbols of Payne et al.; in order to provide a constant reminder to the player of the businesses for potential future business with those companies whose indicia are included as the symbols as suggest, for example, by Colapinto et al. Moreover, absent a showing of criticality with respect to what is appears as symbols on a game of chance is deemed a design choice left to the inventor's discretion.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references above as applied to claim 1 above, and further in view of Dickinson, USPN 5,951,397.

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The references above lack clearly showing a touch screen with a graphical user interface for the player to interact with the gaming machine. Instead, for example, the references above teach using a handle to spin the reels, see e.g. Colapinto et al.; or a plurality of actuating buttons, see e.g. Oranges et al. However, in an analogous gaming device, Dickinson teaches the art recognized equivalents of mechanical actuators to active the gaming machine to a touch screen with a graphical user interface. Those skilled in the gaming arts that players have preferences, some players like to use mechanical actuators because it gives the player a "feel" of control of the outcome of the game; while other players prefer the ease of a touch screen because the player does not have to shift the eyes between the screen and buttons below; thus, causing potential eye-strain and fatigue. Therefore, one skilled in the art would find it obvious to incorporate the touch screen and GUI teachings found in Dickinson for the disclosure of mechanical actuators found in the primary references for the reasoning found in Dickinson which is discussed hereinabove.

Claims 7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 1 above, and further in view of Falconer, USPN 6,832,957.

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Falconer is being provided to show the teaching that it is well known in the art to have a multiplicity of like parts for like effects. As shown in Falconer, there are a plurality of sets of reels, each set having its own game attached thereto. As taught by the reference, providing the multiple sets of like parts makes it easier for the player to see the payline that are being played, see the abstract; and also, makes it easier in programming the game because of reduction in software complexity needed to evaluate the multiple payline, see again the abstract. Therefore, for the reasoning found in Falconer, it would have been obvious to one of ordinary skill in the art to combine the teachings found in Falconer with the disclosure of the combination of primary references discussed above for claim 1; in order to reduce the complexity of gaming operations as previously addressed hereinabove.

Claims 10 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 1 above, and further in view of Sesti et al., USPN 3,706,456.

Sesti et al. is being provided to demonstrate that absent a showing of criticality with respect to the shape of the display for a game, the shape of the display of being a pyramid is obvious to one of ordinary skill in the art as a design choice left to the inventor's discretion. And thus, it would have been



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obvious to one of ordinary skill in the art to incorporate the teachings of a pyramid shape taught in Sesti et al. game to the game disclosed in Payne et al., because of the allowance of either multiple plays or players on or in one game.

### ***Response to Arguments***

Applicant's arguments filed 11-22-04 have been fully considered but they are not persuasive.

It appears that the additional prior art added to the rejections because of the amendments to the claims addresses a majority of the remarks within. Likewise, it appears that the new rejections because of the new language addresses another majority of the remarks therein within respect to certain features now being claimed. The Examiner wishes, though, to make an additional note addressing the Applicant's contention about Payne et al. not showing an input module. With all due respect to the Applicant, input module/means are notoriously well known to those skilled in the gaming machine arts. Although, it might not be shown, it is inherently present in any gaming machine used in any casino in the entire world. As Applicant should be well aware those items that are so well known are preferably omitted from patent application and thus patents that mature therefrom, because to otherwise incorporate that well known material would make the reading of the patent

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cumbersome to those skilled in the art, see e.g. In re Buchner, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991) (Not everything necessary to practice an invention need be disclosed. In fact, what is well-known is best omitted). Input means for gaming machine are notoriously well-known and, absent a showing of criticality for a particular input means, are best omitted from the patent literature.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated

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from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael O'Neill whose telephone number is 571-272-4442. The examiner can normally be reached on Monday through Friday 8:30 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan M. Thai can be reached on 571-272-7147. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



MICHAEL O'NEILL  
PRIMARY EXAMINER